

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): ROSENBERG, Robert D. Examiner: Goon, Scarlett Y.
 et al.

Serial No.: 10/722,587 Group Art Unit: 1623

Filed: November 28, 2003

Title: METHODS FOR SYNTHESIZING POLYSACCHARIDES

RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Response is filed in response to the Restriction/Election Requirement dated September 18, 2008, issued by the United States Patent and Trademark Office in connection with the above-identified Application. A response to the September 18, 2008 Office Action was due October 18, 2008. Applicants are concurrently filing a Petition for a One-Month Extension of Time, including the required fee. Therefore, a response is due November 18, 2008. Accordingly, this Response is being timely filed.

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The Examiner alleged that restriction between the claims of Groups I-III is required. Applicants disagree. MPEP 803 states "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Applicants maintain that such search does not pose a serious burden, in particular due to the relatedness of the claims at issue, directed to a method of preparing a sulfated polysaccharide capable of binding to a binding partner; a method of determining the enzymes that participate in the synthesis of a polysaccharide; and enzymatically synthesized polysaccharides, and accordingly, the restriction is improper.

Applicants elect Claims 1-31, 39, 42-48 and 50-65 of Group I, drawn to a method of preparing a sulfated polysaccharide capable of binding to a binding partner. Upon achieving allowable claims, under M.P.E.P. §821.04, Applicants request rejoinder of claims directed to determining the enzymes that participate in the synthesis of a polysaccharide; and enzymatically synthesized polysaccharides.

Claims 32-34 and 49 of Group II, drawn to a method of determining the enzymes that participate in the synthesis of a polysaccharide, and claims 35-38, 40 and 41 of Group III, drawn to enzymatically synthesized polysaccharides, are withdrawn at this time. Applicants reserve all rights in these non-elected claims, claims 32-38, 40, 41 and 49, to file divisional and/or continuation patent applications.

The Examiner alleged that election of a single disclosed compound is required. Applicants disagree. Applicants maintain that there is no undue burden of search for a method of preparing a sulfated polysaccharide capable of binding to a binding partner. 37 CFR 1.141 provides that a reasonable number of species may rightfully be claimed in one application, even if distinct. Applicants submit that the sixteen species disclosed in claims 50-65 are a reasonable number of species to search. Accordingly, requirement for election is improper.

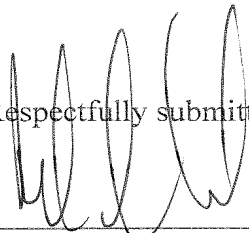
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Applicants elect a method of preparing a sulfated polysaccharide capable of binding to a binding partner, wherein the method comprises at least one enzyme, and wherein the compound is a polysaccharide, as described in claims 1-2, 6-31, 39 and 42-48. Applicants further elect compound 15, a pentasaccharide, as described in claim 63.

If the Examiner has any questions or comments as to this response, the undersigned may be contacted at the address and telephone number below.

Please charge any fees associated with this paper to deposit account No. 50-3355.

Respectfully submitted,



Mark S. Cohen
Attorney/Agent for Applicant(s)
Registration No. 42,425

Dated: November 4, 2007

Pearl Cohen Zedek Latzer, LLP
1500 Broadway, 12th Floor
New York, New York 10036
Tel: (646) 878-0800
Fax: (646) 878-0801